

## REMARKS

Reconsideration and allowance are respectfully requested.

Prior to entry of this amendment, claims 1 and 3-24 were pending in the application. By this amendment, claims 1, 4, 7 and 10 have been amended and claims 3 and 6 have been cancelled. Applicant respectfully submits that no new matter is presented herein.

### Claim rejections - 35 U.S.C. § 112

Claims 1 and 3-24 were rejected under 35 U.S.C. 112, second paragraph.

In particular, according to the Examiner, the detailed description and the drawings denote a portion of a machine for manufacturing cigars while the claims recite a machine for conditioning cigars. Therefore, according to the Examiner, Applicant has failed to particularly point out and distinctly claim the subject matter since Applicant has not recited the claimed machine for conditioning cigars in combination with "a cigar maker" or "a machine for making cigars".

This rejection is respectfully traversed.

Applicant respectfully notes that, "*as noted in In re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section*" (MPEP 2172).

All of the first part of the description (BACKGROUND OF THE INVENTION and

SUMMARY OF THE INVENTION) refers to a ***“machine for conditioning cigars”*** as the core of the invention. Indeed, the first paragraph of the BACKGROUND OF THE INVENTION recites: *“The present invention relates to a machine for conditioning cigars, of which the characterizing features are as recited in the preamble of claim 1 appended”*. The last paragraph of the BACKGROUND OF THE INVENTION recites: *“The object of the present invention is to provide a machine for conditioning cigars such as will be affected neither generally nor even in part by the drawbacks mentioned above, remaining nonetheless functional and economical to operate”*. In addition, the SUMMARY OF THE INVENTION recites: *“The stated objects and others besides, which will emerge more clearly in the course of the following specification, are realized ultimately in a machine according to the invention for conditioning cigars”*. If nothing else was stated in the specification about the invention being directed to a machine for conditioning cigars, the above would be sufficient to so indicate.

Nonetheless, all the description of the prior art (pages 1 to 4 of the BACKGROUND OF THE INVENTION) refers to machines for piercing cigars, so that the smoke can be drawn easily into the mouth when a cigar is lit, and not to overall cigar makers.

Further, the drawings of the present application show a machine for conditioning cigars and not a complete cigar making machine. Indeed, the hopper 4 of figure 1 contains finished cigars 2 ready to be sent to the treatment station 6 by means of the conveyor means 5. See also, the specification at page 6, lines 1-18.

However, in order to clarify the subject matter and to point out that the invention is not something different from what is defined in the claims, the specification has been corrected

(page 4, lines 16-21, and the last paragraph of page 5 of the specification) to recite "a machine for conditioning cigars". In view of the above support for such amendments, no new matter is added by such amendment.

In view of the above, it is believed that the rejection under § 112 has been overcome. Therefore, independent claims 23 and 24 are believed allowable.

### Claim Rejections – 35 U.S.C. § 103

Claims 1-3 and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Noecker.

Claim 1 has been amended by introducing the subject matter of original claim 3.

Amended claim 1 is new and inventive over Noecker. Indeed, Noecker does not disclose and does not suggest that each of its needles 142 is connected directly to an electrical circuit such that an electric current applied to the circuit will also pass through the needle. In contrast, Noecker teaches heating a bar 167 by means of a heating coil 169 and transferring the heat from the bar 167 to the needles 142 only by thermal conduction due to the sliding contact between said bar 167 and said needles 142. This is disclosed at column 6, lines 19 to 41, and figure 6 of Noecker. In particular, figure 6 shows that the coil 169 heats the bar 167 and the heat passes to the needles 142 which slide into the bar 167. There is no electrical current that passes through the Noecker needles.

Noecker therefore belongs to the known prior art acknowledged in the specification of the present application as filed, page 3, lines 9-13 (emphasis added) reciting: "*Furthermore, the needles will be heated typically by thermal conduction, utilizing a heating element*"

*carrying electric current, which is positioned to engage each needle directly and supplied with power by way of sliding contacts".* There is no teaching or suggestion to modify the cigar piercing machine of Noecker in order to achieve the solution as claimed in present claim 1.

The Examiner states that *"since the electrical heating means are provided to heat the needles it follows that one having ordinary skill in the art would have fabricated the needles so as to be connected directly to an electrical circuit."* Applicant respectfully disagrees. The Examiner has not provided any citation to a teaching, suggestion or motivation as to why a person of ordinary skill would pass an electrical current through needles that are already heated by thermal conduction. There is no suggestion of the desirability of doing what the inventor has done (MPEP 706.02(j)). Indeed, according to MPEP 706.02(j), after indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action an explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. *"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."* (Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). There is no such suggestion or line of reasoning and therefore, amended claim 1 is therefore believed to be in allowable condition.

Claims 4, 5 and 7-22 depend from allowable claims 1, 23 or 24 and are also believed allowable.

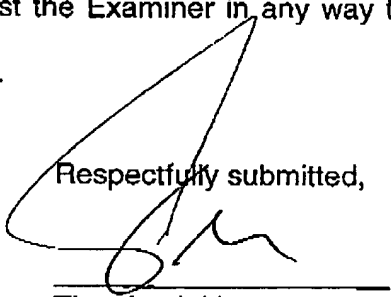
In view of the foregoing, reconsideration and withdrawal of the above rejections is

respectfully requested.

### Conclusion

All matters are addressed above and in view of the pending claims and remarks, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims. Applicant's counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this application.

Respectfully submitted,



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